

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND  
INTERFERENCES

In re application of:

Keith Alan Hankin

Confirmation No.: 8121

Group Art Unit No.: 2163

Examiner: Angela M. Lie

**Serial No.: 10/697,070**

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For: TRACKING SPACE USAGE IN A  
DATABASE

MS Appeal Brief-Patents  
Commissioner for Patents  
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**Request for Rehearing Pursuant 37 CFR 41.50(b)**

On November 24<sup>th</sup>, 2009, the Board of Patent Appeals and Interferences (“Board”) rendered a decision affirming the Examiner’s anticipation rejections under 35 USC § 102. In rendering the decision, the Board failed to recognize gross factual errors committed by the Examiner and committed error in affirming these rejections. The cited art does not anticipate all limitations of claim 1. It is respectfully requested that the Board correct this error and reverse the Examiner’s rejections under § 102.

**Claims 1 and 14**

For the convenience of the Board, claims 1 and 14 are summarized in part pertinent to this Request for Rehearing. Claims 1 and 14 have limitations that mirror each other, except that claim 1 is a method claim and claim 14 is a computer-readable medium. Claim 1 recites:

A method for determining the usage of space in a database, comprising:  
storing, by a first database server, a first set of space usage data that identifies a first amount of free space associated with the database,  
wherein the first set of space usage data is updated, by the database server, based on changes made to the database by the first database server;  
retrieving, from one or more second database servers, a second set of space usage data that identifies a second amount of free space associated with the database,  
wherein the second set of space usage data is updated, by the one or more database servers, based on changes made to the database by the one or more second database servers;  
updating the first set of space usage data with the second set of space usage data; and  
evaluating the usage of space in the database based on the updated first set of space usage data.

As highlighted in the Appeal Brief (“Brief”) (e.g. page 13, last paragraph), Claim 1 requires two separate sets of space usage data, “a first set of space usage” and “a second set of space usage”. Both identify “an ... amount of free space associated with the [same] database”, except that the first is “updated... based on changes made to the database by the first database server” and the second is “updated ... based on changes made to the database by ”a different “one or more second database servers.” Thus, the first and second set of space usage data are similar in that both reflect an amount free space in a database but are different in that each reflects free space based on changes made by different sets of database servers.

Finally, claim 1 requires updating “the first set of space usage data with the second set of space usage data”.

### **The Board Failed to Recognize a Clear Factual Error Regarding the Finding that Chinta Taught A Second Set of Space Usage Data Used to Update the First**

The Decision states the Answer “sets forth a detailed correspondence of the claimed features of representative claim 1...” This is where the Examiner attempts to establish a prima facie case. The detailed correspondence expressly correlates two separate passages to

claimed features, each teaching one of the first and second sets of space usage data. In the detailed correspondence, for the first set of space usage data, the Examiner relies on column 39, lines 53 – 56, and figure 23. (see Answer page 4, last line to page 5, first line). For the second set of space usage data that is used to update the first, the Examiner relies on passage column 14, lines 3 – 9 (See Answer page 5, line 8).

With respect to the passage cited for the first set of space usage data (i.e. column 39, lines 53 – 56), these passages teach that an application server checks for an out-of-storage condition in storage space used to store a message log. The Examiner correlated the application server storing a status about the out-of-storage condition to the first set of space usage data. For purposes of argument here, it is assumed that the out-of-storage condition status stored by the application server can be equated to the first set of space usage data.

With respect to the passage for the second set of space usage data used to update the first, the detailed correspondence includes “a second set of space usage data (**column 14, lines 3 – 9**) that identifies a second amount of free space associated with the database (Figure 2C, 110).” (Answer page 5, lines 8 – 9, emphasis added). This passage teaches about load balancing information that is broadcasted between application servers. However, as stated in the Brief (page 16, fifth paragraph) “[l]oad balancing information is not the claimed “second set of space usage data ....” There is nothing about disclosing load balancing information that even discloses space usage data that identifies an amount of free space in a database. Clearly, the passage relied upon to teach the second set of space usage data fails to even teach space usage data, much less second space usage data that is used to update another first set of space usage data. Thus, the rejection rests on passages that cannot possibly teach using the second set of space usage to update another first set of space usage data, as claimed.

### The Board and Examiner Commit Error by Contradicting Themselves About What in the Cited Art is the First and Second Space Usage Data.

As noted by the Decision, in the Answer the Examiner made “responsive arguments, directed to the positions set forth in the Brief, beginning at page 10 of the Answer that address each of the major arguments presented by Appellant in this Brief.” The Board adopted this responsive argument, and in so doing, specifically committed error in adopting the part of Answer rebutting Applicant’s argument in the Brief about the load balancing information cited at column 14, lines 3 – 9. Given that the prima facie case of the rejection relies on correlating the load balancing information to the second space usage data, one would expect the Examiner to answer any rebuttal of this correlation with teachings in Chanti that are germane to the load balancing information, and more particularly, teachings germane to why the loading balancing information is the second set of space usage data. Instead, the Examiner relies on teachings about what in the prima facie case the Examiner alleges is the other set of space usage data, the first space usage data. Specifically, in the pertinent part of the Answer the Examiner argues how the out-of-storage status being updated is the second set of space usage data. (Answer, page 14, first full paragraph) There is no mention of load balancing information in this part of the Answer, much less any mention of why the load balancing information reads on the second set of space usage data.

Thus, the Examiner in the prima facie case relies on the out-of-storage condition of Chanti to teach the first set of space usage data and the load balancing information of Chanti to teach the second set of space usage information. In the portion of the answer addressing the Applicant’s argument rebutting these correlations, the Examiner relies on the out-of-storage condition being the second set of space usage. Thus, the Examiner flip-flops between contradictory positions of: (1) the second set of space usage data is loading balancing

information and is not the out-of-storage condition, and (2) the second set of space usage data is the out-of storage condition. It is a clear error to adopt and rely on both positions.

### **The Board Should Not Find Sua Sponte That the Load Balancing Information Inherently Teaches Space Usage Data**

The Board may be tempted to find that load balancing information implies space usage data that specifies an amount of free space in a database. However, anticipation requires that that which is implied by a teaching must be inherently described. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” Inherency, however, may not be established by probabilities or possibilities.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) Chinta teaches load balancing information is “information ... such as server load criteria and application component performance criteria”. However, it does not necessarily follow that such information includes information specifying an amount of free space in a database.

### **Parts of Answer Regarding Separate Storage Space are not Relevant**

Much ado is made by the Answer about Applicant arguing “separate storage spaces to which first and second set of data corresponds to”. In fact, the claims require that the first and second set of space usage data both specify an amount of free space in the same database. As explained earlier, the amounts specified are based on changes made by different database servers.

Applicant never asserted that “separate storage spaces to which first and second set of data corresponds.” This argument reqs simply mischaracterizes Applicant’s position and the

Board should not waste its time on this issue because rebutting an argument Applicant never made is not relevant.

## CONCLUSION

In affirming the Examiner, the Board expressly adopted the findings of the Examiner. (Decision, page 5, first full paragraph) As shown above, the Examiner committed factual error in finding that Chinta taught second usage data that is used to update the first usage data. The Board affirmed a clearly erroneously factual finding upon which the rejection in issue depends, and must therefore reverse the Examiner's rejection.

Respectfully submitted,

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Dated: January 24<sup>th</sup>, 2010

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